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**OFFICE OF PETITIONS**

In re Application of	:	
Yoshito KURODA et al.	:	
Application No. 10/500,882	:	ON PETITION
Filed: July 7, 2004	:	
Attorney Docket No. 0216-0510PUS1	:	

This is in response to the petition under 37 CFR 1.59(b), filed September 8, 2006, to expunge information submitted under MPEP 724.05(III), which is being treated as a petition under 37 CFR 1.181 requesting removal of a third party submission under 37 CFR 1.99 or protest under 37 CFR 1.291.

The petition is **GRANTED**.

Petitioner requests that a PTO/SB/08 filed with an incorrect heading by a third party on April 17, 2006 and considered by the examiner in the Notice of Allowability mailed June 19, 2006 be expunged. The form PTO/SB/08 filed April 27, 2006 contains the application number of the instant application; however, none of the other identifying data on the form, i.e., filing date, first named inventor, art unit, examiner name, and attorney docket number, correspond to the instant application. A Supplemental Notice of Allowability was mailed by the Office October 19, 2006 and indicated that the form PTO/SB/08 filed April 27, 2006 was not a paper for the instant application.

Since this application was the subject of a pre grant publication (PG Pub) prior to the filing of the above-noted documents, the provisions of the statute (35 U.S.C. § 122(c)) the applicable rules (e.g., 37 CFR §§ 1.99, 1.291, and 1.292) and procedures (e.g., MPEP §§ 1134.01, 1901.06) now place stringent limitations on the treatment, or even on the retention *vel non* in this file, of any third party submissions that protest, oppose the grant of, or seek to have other information entered and considered in, this application. See also *Third Party Attempts to Protest or Otherwise Oppose the Grant of a Published Application*, 1269 Off. Gaz. Pat. Office 179 (April 22, 2003)

37 CFR 1.99 requires, in pertinent part that:

- (c) The submission under this section must be served upon the applicant in accordance with § 1.248.

(d) A submission under this section shall not include any explanation of the patents or publications, or any other information. The Office will not enter such explanation or information if included in a submission under this section. A submission under this section is also limited to ten total patents or publications.

(e) A submission under this section must be filed within two months from the date of publication of the application (§ 1.215(a)) or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier. Any submission under this section not filed within this period is permitted only when the patents or publications could not have been submitted to the Office earlier, and must also be accompanied by the processing fee set forth in § 1.17(i). **A submission by a member of the public to a pending published application that does not comply with the requirements of this section will not be entered** (emphasis added).

As the submission was not filed within two months of the date of publication of the application, it is time barred.

Likewise, even treating the documents in question as a protest, 37 CFR 1.291(b) does not permit retention of the submission/protest in this file record:

(b) The protest will be entered into the record of the application if, in addition to complying with paragraph (c) of this section, the protest has been served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and, except for paragraph (b)(1) of this section, the protest was filed prior to the date the application was published under § 1.211, or a notice of allowance under § 1.311 was mailed, whichever occurs first:

(1) If a protest is accompanied by the written consent of the applicant, the protest will be considered if the protest is matched with the application in time to permit review during prosecution.

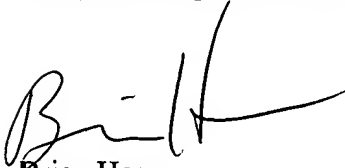
(2) A statement must accompany a protest that it is the first protest submitted in the application by the real party in interest who is submitting the protest; or the protest must comply with paragraph (c)(5) of this section. This section does not apply to the first protest filed in an application.

Here, the protest was filed subsequent to publication and is thus time barred.

In view of the above, the PTO/SB/08 filed April 17, 2006 and the initialed and dated copy of such attached to the Notice of Allowability mailed June 19, 2006 will be removed from the official file.

As the instant petition is being treated as a petition under 37 CFR 1.181, no petition fee is required. Accordingly, the petition fee of \$200 will be credited to petitioners Deposit Account No. 02-2448.

Telephone inquiries regarding this decision should be directed to David Bucci at (571) 272-7099.

A handwritten signature in black ink, appearing to read 'Brian Hearn', with a stylized flourish extending from the end.

Brian Hearn  
Petitions Examiner  
Office of Petitions